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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,238	12/05/2001	James G. Shanahan	D/A1320	8310

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EXAMINER	
RIES, LAURIE ANNE	
ART UNIT	PAPER NUMBER
2176	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/683,238

**Applicant(s)**

SHANAHAN ET AL.

**Examiner**

Laurie Ries

**Art Unit**

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9-14,16-18 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9-14,16-18 and 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 27 November 2006, to the Original Application, filed 5 December 2001.
2. Claims 1, 3-6, 9-14, 16-18, and 21-26 are pending. Claims 2, 7-8, 15, and 19-20 have been cancelled. Claims 1, 11, and 21 are independent claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-6, 9, 11-12, 16-18, and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647), hereafter referred to as "Horowitz '647", in view of Horowitz (U.S. Patent 6,236,987 B1), hereafter referred to as "Horowitz '987", and Reber (U.S. Patent 5,986,651).

**As per independent claims 1, 11, and 21**, Horowitz '647 discloses a system, article of manufacture and method for enriching (or annotating with a predefined theme)

Art Unit: 2176

the content of a document by enriching at a meta-document server the identified document content using a set of document service requests (See Horowitz '647, Column 10, lines 8-27) and making the enriched document content available at the server (See Horowitz '647, Column 11, lines 39-40).

Horowitz '647 does not disclose expressly a personality identifier associated with a database of personalities defining enrichment themes, where the enriching recognizes and annotates entities in the identified document content related to the enrichment theme of the associated personality, or recording the personality identifier from the identifier tag with a reader.

Horowitz '987 discloses using a topic ID, recorded with a dynamic content organization module, which reads the content (See Horowitz '987, Column 10, lines 41-61) into a database on a computer, and therefore digitally readable, which is associated with a topic, or personality, in a database of topics, or personalities (See Horowitz '987, Column 8, lines 36-67, Column 9, lines 1-5, and Column 10, lines 36-41). Horowitz '987 also discloses a supertopic arrangement containing associated subtopics, which can be used to enrich a document based on the specific supertopic (See Horowitz '987, Column 11, lines 52-67, and Column 12, lines 1-26), and annotating entities in the identified document content related to the associated supertopic (See Horowitz '987, Column 8, lines 52-67 and Column 9, lines 1-29).

Horowitz '647 also does not disclose assigning different personality identifiers including time information and position information, recorded with an electronic tag reader including a transmitter and receiver to read an electronic identification tag.

Reber discloses a network navigation device from which electronic identification data may be read, which includes a transmitter and receiver (See Reber, Column 4, lines 45-60, Figure 3, element 56, and Column 7, lines 59-63). Reber also discloses recording context information including a time of year during which data is recorded by the reader (See Reber, Column 14, lines 60-67, Column 15, lines 1-8, and Column 16, lines 29-35). Reber also discloses recording position information, such as the location of machine-readable data in relation to the substrate (i.e. the location within the header or footer of the page)(See Reber, Column 15, lines 52-62, Column 16, lines 29-36, Figure 14, Column 14, lines 60-67, and Column 15, lines 1-2).

Reber also discloses identifying document content within the reader using the recorded context information (See Reber, Column 7, lines 59-63), and transmitting from the reader the identified document content to a server (See Reber, Column 13, lines 34-50).

Horowitz '647, Horowitz '987, and Reber are analogous art because they are from the same field of endeavor of embedding data into documents.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the subtopic ID and supertopic ID arrangement of Horowitz '987 with the method of Horowitz '647. The motivation for doing so would have been to determine topic intersections of interest to the user (See Horowitz '987, Column 11, lines 52-56)

At the time of the invention it would also have been obvious to include the electronic identification tag and reader of Reber with the document enrichment system

Art Unit: 2176

and method of Horowitz '647 and Horowitz '987. The motivation for doing so would have been to allow a user to access a document by reading the electronic identification tag rather than typing in an address, thereby making the addressing format and the address itself transparent to the user and consequently reducing the complexity of navigating a collection of documents (See Reber, Column 3, lines 20-28).

Therefore it would have been obvious to combine Horowitz '987 and Reber with Horowitz '647 for the benefit of determining topic intersections of interest to the user, supporting the highlighting or annotating of a subset of data, and reducing the complexity of navigating a collection of documents to obtain the invention as specified in claims 1, 11, and 21.

**As per dependent claim 3**, Horowitz '647, Horowitz '987 and Reber disclose the limitations of claim 1 as described above. Horowitz '647 also discloses that the meta-document server, upon identification of the document content, associates the personality ID with the identified document content (See Horowitz '647, Figure 8, element 808), that the meta-document server recognizes, with at least a first method, an entity in the document content (See Horowitz '647, Column 8, lines 50-61), that the meta-document server accesses, with at least a second method, a document service using the recognized entity (See Horowitz '647, Column 9, lines 28-63), that the meta-document server annotates the identified document content with output from the document service to define enriched document content (See Horowitz '647, Figure 8, element 810, and Column 10, lines 22-27), and that the meta-document server makes

Art Unit: 2176

the enriched document content available to a set of one or more users (See Horowitz '647, Column 11, lines 39-40).

**As per dependent claims 4-6 and 9**, Horowitz '647, Horowitz '987, and Reber disclose the limitations of claim 1 as described above. Reber also discloses recording the digitally readable ID from an electronic tag with an electronic tag reader, where the reader includes a transmitter and a receiver (See Reber, Column 4, lines 45-55, Figure 9, Column 10, lines 62-67, and Column 11, lines 1-6). Reber also discloses recording the digitally readable ID from embedded data recorded on a hardcopy document with a scanner (See Reber, Column 4, lines 45-55). Reber also discloses that the digitally readable ID may be recorded with a mobile computing device that identifies position coordinates where data is recorded (See Reber, Column 4, lines 24-30, Column 14, lines 60-67, and Column 15, lines 1-8). Reber also discloses that the recorded context information is time information including a timestamp (See Reber, Column 14, lines 60-67, and Column 15, lines 1-8). Horowitz '647, Horowitz '987, and Reber are analogous art because they are from the same field of endeavor of embedding data into documents. At the time of the invention it would also have been obvious to include the electronic identification tag and reader of Reber with the document enrichment system and method of Horowitz '647, Horowitz '987, and Reber. The motivation for doing so would have been to allow a user to access a document by reading the electronic identification tag rather than typing in an address, thereby making the addressing format and the address itself transparent to the user and consequently reducing the complexity of navigating a collection of documents (See Reber, Column 3, lines 20-28). Therefore it

Art Unit: 2176

would have been obvious to combine Reber with Horowitz '647, Horowitz '987, and Reber for the benefit of determining topic intersections of interest to the user, supporting the highlighting or annotating of a subset of data, and reducing the complexity of navigating a collection of documents to obtain the invention as specified in claims 4-6 and 8-9.

**Dependent claim 12** is rejected on the same basis as claim 4.

**Dependent claim 13** is rejected on the same basis as claim 5.

**Dependent claim 14** is rejected on the same basis as claim 6.

**Dependent claim 16** is rejected on the same basis as claim 9.

**Dependent claim 17** is rejected on the same basis as claim 8.

**As per dependent claim 18**, Horowitz '647, Horowitz '987, and Reber disclose the limitations of claim 1 as described above. Horowitz '987 also discloses providing notification that the enriched document content is available (See Horowitz '987, Figure 12, element 1210, and Column 22, lines 16-19). Horowitz '647, Horowitz '987, and Reber are analogous art because they are from the same field of endeavor of embedding data into documents. At the time of the invention it would also have been obvious to include the notification of available enriched content of Horowitz '987 with the document enrichment system and method of Horowitz '647, Horowitz '987, and Reber. The motivation for doing so would have been to provide the enriched data to the user organized in such a way so as to provide the user with an understanding of the organization, relationships, and nature of the content in the document collection (See Horowitz '987, Column 22, lines 20-25). Therefore, it would have been obvious to



combine Horowitz '987 with Horowitz '647, Horowitz '987 and Reber for the benefit of providing the enriched data to the user organized in such a way so as to provide the user with an understanding of the organization, relationships, and nature of the content in the document collection to obtain the invention as specified in claim 18.

**Dependent claim 19** is rejected on the same basis as claim 3.

**Dependent claim 23** is rejected on the same basis as claim 5.

**Dependent claim 24** is rejected on the same basis as claim 9.

**Dependent claim 25** is rejected on the same basis as claim 18.

**Dependent claim 26** is rejected on the same basis as claim 4.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz (U.S. Patent 6,122,647), hereafter referred to as "Horowitz '647", in view of Horowitz (U.S. Patent 6,236,987 B1), hereafter referred to as "Horowitz '987", and Reber (U.S. Patent 5,986,651) as applied to claim 1 above, and further in view of Keith (U.S. Publication 2002/0032672 A1).

**As per dependent claim 10**, Horowitz '647, Horowitz '987, and Reber disclose the limitations of claim 1 as described above. Horowitz '647, Horowitz '987, and Reber do not disclose expressly providing notification that the enriched document is available. Keith Jr discloses notifying a user regarding updated data (See Keith Jr, Pages 10-11, paragraph 0092). Keith Jr, Horowitz '647, Horowitz '987, and Reber are analogous art because they are from the same field of endeavor of processing electronic data. At the

time of the invention it would have been obvious to a person of ordinary skill in the art to include the user notification of updated data of Keith Jr with the enriched document of Horowitz '647, Horowitz '987, and Reber. The motivation for doing so would have been to push information to users when desired new information is entered into the system (See Keith Jr, Page 11, paragraph 0092). Therefore, it would have been obvious to combine Keith Jr with Horowitz '647, Horowitz '987, and Reber for the benefit of pushing information to users when desired new information is entered into the system to obtain the invention as specified in claim 10.

### ***Response to Arguments***

5. Applicant's arguments filed 27 November 2006 have been fully considered but they are not persuasive.

Applicant argues that Horowitz '647 in combination with Horowitz '987 and Reber fails to teach using recorded context information (both time and position) as recited in claim 1. The Office respectfully disagrees. Reber teaches recording context information related to machine-readable data, which includes time information, such as a time at which the resource was visited or a time at which the hard copy was printed (See Reber, Column 15, lines 4-8) as well as position information, such as the location of the machine-readable data in relation to the substrate (i.e. the location within the

header or footer of the page)(See Reber, Column 14, lines 60-67, and Column 15, lines 1-2).

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

Art Unit: 2176

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

*William L. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**